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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,539	03/29/2001	Kazutoyo Maehiro	6514-5	4166

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GREENBLUM & BERNSTEIN, P.L.C.  
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RESTON, VA 20191

EXAMINER

HARRISON, JESSICA

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/820,539

Applicant(s)

MAEHIRO, KAZUTOYO

Examiner

Jessica J. Harrison

Art Unit

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 11 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-5.  
Claim(s) withdrawn from consideration: 6.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☒ Other: IDS Considered.

  
Jessica J. Harrison  
Primary Examiner  
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***Response to Amendment After Final Rejection***

Denial of instant amendment after final:

Applicant's request for reconsideration of the finality of the rejection of the last Office action is not persuasive and, therefore, the finality of that action stands. With the issue of finality more fully addressed hereinbelow, applicant's proposed amendments to claims 2, 3 and 5 will not be entered as these proposals clearly and substantively add structure resulting in a scope of invention not previously considered. Clearly the addition to claim 2 of a receiver that receives specific personal information including whether the user is a child in the game machine has not previously been considered. The definition of the claimed 'utilization state comprising at least three states' as recited in claim 3 has never been considered. Further, it is noted applicant maintains claim 6 status as "previously presented" when the appropriate status identifier is "withdrawn".

Reconsideration of Final Rejection:

Applicant submits the finality of the prior office action was premature because the advisory action indicated denial of entry due to 'new issues' being raised. Indeed, this box was checked on the advisory action form. However, the content of the advisory action's explanatory note clearly delineated the examiner's position that it was the proposed addition of a new claim after final which would require further consideration, while the proposed amendments to the claims constituted the addition of intended use to an apparatus claim and

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as such were not further limiting. It would have been entirely appropriate to have checked box 2(d) which states " they present additional claims without canceling a corresponding number of finally rejected claims" instead of box 2(a) on said advisory form.

Upon consideration of this amendment when entered under RCE practice, it was determined by the examiner the newly added claim in the RCE application was directed to an independent or distinct invention. Since applicant had received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 6 was withdrawn from consideration as being directed to a non-elected invention. When withdrawn, no new issue remained and the application met all the requirements for issuance of a proper final rejection on first action. This line of reasoning was again advanced in the subsequent first action final rejection.

Summed differently, applicant may not circumvent the tenants of compact prosecution by merely proposing the addition of a distinct claim to a different invention in order to secure a checked box that guarantees two additional opportunities to advance prosecution. As each application is reviewed on it's own merits, there are no absolutes. The balance struck between the Office and applicant in continuing prosecution is that applicant is fairly noticed and not prematurely denied prosecution rights in exchange for applicant advancing prosecution of his application. Here, it is felt applicant

was properly and fully noticed as to the effect of his actions in the advisory action and that the finality of the first office action in the RCE was appropriated. Applicant did not have to enter the denied proposed amendment: He could have further amended his proposal to ensure a change in scope of the apparatus claims and/or amended the new method claim to be commensurate in scope with his constructively elected invention. Applicant did neither.

Should applicant still feel the examiner has acted prematurely, he is reminded this is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Patent Appeals and Interferences. It is, however, reviewable by petition under 37 CFR 1.181.

Comments regarding claim withdrawal:

In response to the restriction requirement, applicant argues that claim 6 pertains to forwarding status information from a game server to a profile server in response to receiving an access request. Applicant sees a common feature with claim 1, for example, in that "all claims are directed to informing status", and further appears to allege claim 6 is in actuality a species of claim 1 with "claim 6 recites a specific embodiment of claim 1". Applicant also urges claim 6 does not have separate utility from claim 1 because both claims forward information.

Respectfully, the examiner disagrees. Applicant's first two points fail in that these are not the standards for distinctness. Applicant's claims also share the common feature of use of a server. They are, however, clearly distinct from stock trading over the internet which also shares both the common features of informing status and use of a server.

Further the standard for separate utility is not predicated on a common function of the claims. It is a potential use, as claimed, that is distinct from the disclosed combined use. This separate utility was established by the examiner in the example of the invention of claim 6 has separate utility such as merely inquiring as to availability status of a system user, rather than managing personal data to the detail claimed in claims 1-5. The burden is on the examiner to provide an example. Only one way distinctness need be asserted. Claim 6 is directed to the method of receiving and forwarding the name of a name of a client and game. Claim 1 is directed to a system for providing information services including the structure for storing and managing information. This example was provided by the examiner.

If applicant proves or provides an argument, supported by facts, that the other use, suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative use or withdraw the requirement. Applicant has provided no such evidence or fact. Therefore, his allegation that claim 6 does not have separate utility from claim 1 is not persuasive.

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Comments to claim interpretation/prior art rejections:

Continuing, applicants request for consideration argues that claim 1 requires information to be forwarded from one server to another server. The game machine then receives this information. In contrast, applicant asserts the prior art to TANG discloses PC to PC communications, therefore can not anticipate.

First, looking at the common definition of a server,

**serv-er** (sûr' ver) *noun*

1. a. One who serves food and drink. b. Something, such as a tray, that is used in serving food and drink.
2. An attendant to the celebrant at Mass.
3. *Sports*. The player who serves, as in court games.
4. *Computer Science*. **A computer or program that controls a central repository of data that can be**

**downloaded and manipulated in some manner by a client.**<sup>1</sup>

There is nothing in the definition that precludes a PC from being a server, and it explicitly states that server encompasses software. Notwithstanding, applicant's claims require a profile server storing personal information and and information server providing information services (it is not know what 'centralized system' applicant argues equates to). Noting TANG col. 11, lines 40+, the directory server 129 functions as the profile server storing personal information (contrary to opinion expressed, and person's name is deemed to be personal information) and at least the chat room server 131 provides information services. Alternatively, the gallery mechanism functions as a server for storing personal information, as business card 29 necessarily is

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<sup>1</sup>The American Heritage® Dictionary of the English Language, Third Edition copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction

stored if it can be retrieved. In sum, the breadth of applicant's chosen claim language encompasses that which is shown in TANG and therefore does not distinguish from that which is shown. Applicant's remaining comments at this time appear to relate to the claims amended as proposed, and can not be responded to here.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica J. Harrison whose telephone number is 571-272-4449. The examiner can normally be reached on M-F during business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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A handwritten signature in black ink, appearing to read 'J. Harrison', with a long horizontal stroke extending to the right.

Jessica J. Harrison  
Primary Examiner  
Art Unit 3714

jjh